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SUGHRUE MION, PLLC				
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
FISCHER, JUSTIN R				
ART UNIT		PAPER NUMBER		
1747				
NOTIFICATION DATE		DELIVERY MODE		
02/23/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/562,947

Applicant(s)

SUZUKI ET AL.

Examiner

Justin R. Fischer

Art Unit

1747

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5, 6, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta (US 5,396,940, of record) and further in view of Imamura (US 3,913,652, of record) and Scriver (US 4,192,366, of record).

Segatta is directed to a rubber composition comprising 5-95 phr of epoxidized natural rubber (claimed natural rubber), 5-95 phr of cis 1,4 polyisoprene, and 5-85 phr of silica (Column 1, Lines 63+). In this instance, given the general disclosure of Segatta, one of ordinary skill in the art at the time of the invention would have found it obvious to form a composition consisting of natural rubber and cis 1,4 polyisoprene within the claimed loadings (i.e. natural rubber expressly disclosed as being included at 95 phr).

While Segatta is silent with respect to the cis 1,4 content and associated Mooney viscosity, the claimed characteristics are consistent with the conventionally used polyisoprene rubbers in the tire industry, as shown for example by Imamura (Column 2, Lines 22-25) and Scriver (Column 2, Lines 20-25). Absent any conclusive showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to use the claimed cis 1,4 polyisoprene.

As to claims 5 and 6, the composition of Segatta includes between 5 and 85 phr of silica having a surface area between 40 and 600 m²/gram. Absent any conclusive

showing of unexpected results, one of ordinary skill in the art at the time of the invention would have found it obvious to select a surface area of at least 180 m²/gram.

Regarding claims 10 and 11, the language "used for tread" and "used for a casing member" do not further define the makeup of the claimed rubber composition.

As to claim 12, the rubber composition of Segatta is used for the manufacture of tire treads and/or carcass plies (casing member).

With respect to claims 13 and 14, the disclosed loadings would have been obvious to one having ordinary skill in the art since they are consistent with "typical" or conventional loadings, as shown for example by Scriver. It is further noted that applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed loadings.

Response to Amendment

3. The declaration under 37 CFR 1.132 filed February 14, 2011 is insufficient to overcome the rejection of claims 1, 5, 6, and 10-14 based upon Segatta as set forth in the last Office action because: Table C does not establish a conclusive showing of unexpected results for a cis 1,4 bond content greater than 99%. In particular, a comparison of Examples A and Comparative Examples F and G suggests that the difference in durability is extremely small (on the order of 4%). Looking at Example B and Comparative Examples H and I, on the other hand, a difference in tire durability on the order of 17% is realized. It is emphasized that the claims as currently drafted are directed to a wide variety of embodiments in which the amount of cis 1,4 polyisoprene can be as low as 5% and Table C fails to provide a conclusive showing of unexpected

results to establish a criticality for the claimed cis 1,4 content over the entire range of rubber component loadings. It is emphasized that Segatta expressly teaches an embodiment having 5 phr of cis 1,4 polyisoprene and applicant's declaration suggests that such compositions demonstrate extremely similar tire durability, independent of the cis 1,4 content (no showing of unexpected results).

Also, Table D suggests that a cis 1,4 content above and below 99% results in a tire having the same processability, wear resistance, and durability (Additional Comparative Example J and Additional Comparative Example L). It should be noted that while Comparative Example J has a 3,4 content greater than 0.5%, it is unclear how such a content can be below 0.5% in embodiments where the cis 1,4 content is between 99% and 99.5% (is additional structure present ?)..

Response to Arguments

4. Applicant's arguments filed February 14, 2011 have been fully considered but they are not persuasive. More particularly, applicant's arguments have been addressed in the previous paragraph.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Fischer
/Justin R Fischer/

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Primary Examiner, Art Unit 1747

February 16, 2011